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EXAMINER
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/664,101  
Filing Date: September 17, 2003  
Appellant(s): BARTKOWSKA ET AL.

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Michael P. Aronson  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed August 27, 2009 appealing from the Office action mailed May 5, 2009.

**(1) Real Party in Interest**

A statement identifying by name the real party interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct.

Appellant's brief and the final rejection mailed May 5, 2009, recites "Claims 1-5, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brake (US 6432466) in view of the combination of Jonas (US 4971824) and Arbuckle (Ice Cream, 2nd Edition 1972, page 96)." It is noted that in the final rejection mailed May 5, 2009, to which claim 23 was a newly added claim, a typographical error was made in the heading of the rejection and although claim 23 was clearly addressed in the body of the rejection it was not included in the heading. Thus, the rejection remains as previously presented and the correct rejection heading is "Claims 1-5, 20, 21, and 23 are rejected

under 35 U.S.C. 103(a) as being unpatentable over Brake (US 6432466) in view of the combination of Jonas (US 4971824) and Arbuckle (Ice Cream, 2nd Edition 1972, page 96)."

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

<b>WO 02/094035 A1</b>	<b>KOSS</b>	<b>11-2002</b>
<b>US 6,432,466</b>	<b>BRAKE et al</b>	<b>8-2002</b>
<b>US 4,971,824</b>	<b>JONAS</b>	<b>11-1990</b>

***Arbuckle, W.S., Ice Cream Second Edition The AVI Publishing Group 1973,  
page 96.***

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-5, 21, and 23 are rejected under 35 U.S.C. 102(a) as being anticipated by Koss (WO 02/094035 A1).

Koss teaches of frozen products (Abstract) that are aerated with an overrun of 30% and have a pH of about 4.5 when frozen, and thus a pH 4.5 when melted as pH is a compositional property and is not altered by the physical state of the matter (page 25 lines 17-21 and Example 3 pages 29 and 30). Koss teaches that the products include water (Examples 1-6 pages 27-30), 1.1-1.8% nonfat dry milk which is skim milk powder (page 9 lines 20-30, Example 1 page 27, and Example 5 page 31), about 0.02-22% sweetener (page 4 lines 1-8, page 5 lines 24-28, and page 14 lines 10-27), 0-20% fat (page 19 lines 20-26), and about 0.5-20% flavoring substances including cherry, raspberry, and strawberry fruit puree (page 24 lines 4-32). Note: Milk which is included in some of the examples of Koss includes water and thus by teaching the addition of

milk to the product, Koss teaches the addition of water to the product. Koss teaches that the product optionally includes stabilizers, thus teaching that the product includes no additional stabilizers or some additional stabilizers (page 21 lines 1-2 and page 9 lines 11-13). Koss teaches that the product optionally includes emulsifiers, thus teaching that the product includes no additional emulsifiers or some additional emulsifiers (page 21 lines 1-2 and page 9 lines 11-13).

Regarding the product as including 0.05 to about 1.5% soluble dietary fiber and 0.1 to about 5% insoluble dietary fiber, as recited in claim 1 and 23, preferably about 0.1 to about 1.2% soluble dietary fiber and 0.2-2% insoluble dietary fiber as recited in claim 4, most preferably about 0.2-1% soluble dietary fiber and about 0.3-1% insoluble dietary fiber as recited in claim 5, wherein the fibers are derived from one or more fruit or vegetables, preferably purees, as recited in claims 2 and 3, as the instant claims, specifically independent claims 1 and 23, recite that a fruit and/or vegetable puree is added to the product to provide the necessary soluble and insoluble fibers and that the fruit puree is added from about 5-80%; as appellant states in the specification, page 5 line 30 through page 6 line 15, that the necessary dietary fiber is provided by about 5-80% fruit puree including cherry, raspberry and strawberry purees; and as Koss teaches that the composition contains 0.5-20% fruit puree, including raspberry, cherry, and strawberry, one of ordinary skill in the art at the time the invention was made would expect that the composition as taught by Koss, which includes 0.5-20% fruit puree, inherently encompass the instantly claimed amount of fiber, wherein the fiber is derived from fruit puree absent any clear and convincing arguments and/or evidence to the contrary; i.e. Since appellant claims and discloses that the claimed fiber is derived from 5-80% fruit puree, including from raspberry puree, and Koss teaches of adding the same type of fruit puree, including raspberry, within the same compositional range, the fruit puree of Koss would inherently impart substantially the same composition properties, i.e. substantially the same amount of fibers, as the instantly claimed fruit puree, and as no other fiber ingredients are instantly claimed or taught by Koss, the final product of Koss would contain substantially the same amount of fibers as the instantly

claimed product absent any clear and convincing arguments and/or evidence to the contrary.

Regarding the method in which the instantly claimed product is made as recited in claim 1, Koss teaches that the product is produced by the instantly claimed method b, including homogenizing and pasteurizing a premix containing water, fat, nonfat milk solids, and sweetener, cooling the pasteurized mix, and then adding to the cooled mix a fruit puree which inherently contains sufficient fiber as discussed above (page 4 lines 13-16, page 9 lines 11-16, page 10 line 20 through page 11 line 3, page 23 lines 6-10, page 24 lines 1-32).

Regarding the method in which the instantly claimed product is made as recited in claim 23, the claim is directed towards a product recited in a product by process claim and Appellant is reminded that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). In the instant case, since appellant claims (claim 1) and discloses in the specification (page 9 line 14 through page 11 line 5) that the same product can be made by two methods (methods a or b), and Brake teaches of producing a product which is made by method b, wherein a premix comprising water, fat, non fat milk solids and sweetener is homogenized and pasteurized, cooled, and then mixed with a fruit puree, the instantly claimed product made by method a as recited in claim 23 which is made by adjusting the pH of the fruit puree to a value above the isoelectric point of any protein to be incorporated in the product, followed by producing a premix comprising fat, non-fat milk solids, sweetener, and about 5-80% of the fruit puree, and then homogenizing and pasteurizing the premix would be substantially the same as the product taught by Brake, absent any clear and convincing arguments and/or evidence to the contrary.

Regarding the meltdown initiation time of the product as greater than 120 minutes when measured at 20C and the resistance to meltdown and serum leakage

properties of the product as recited in claims 1 and 23 and to the meltdown initiation time as greater than 180 minutes as recited in claim 21, as Koss teaches of a frozen product with substantially the same composition as that as instantly claimed and produced by substantially the same method as instantly claimed, one of ordinary skill in the art at the time the invention was made would expect the frozen product as taught by Koss inherently have substantially the same properties, including meltdown initiation time, resistance to meltdown, and serum leakage properties, as the instantly claimed invention, absent any clear and convincing arguments and/or evidence to the contrary.

Claim 20 is rejected under 35 U.S.C. 103(a) as Koss (WO 02/094035 A1) in view of Brake et al. (US 6432466 B2).

Koss teaches of a frozen confection containing a fruit puree and about 1-2% nonfat milk solids as discussed above. Koss is silent to the confection as including 4-6.5% non-fat milk solids as recited in claim 20.

Brake et al. (Brake) teaches that milk solids non fat were included in frozen confections with fruit purees from 0-10% in order to provide textural properties (Abstract, Column 3 lines 16-25, and Column 4 lines 21-41).

Regarding the confection as including 4-6.5% non fat milk solids, it would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust the nonfat milk solids in the fruit puree frozen confection as taught by Koss to 0-10% depending on the desired textural properties of the final product as taught by Brake. To adjust the level of a known ingredient within known amounts for its known function would have been obvious and routine determination of one of ordinary skill in the art at the time the invention was made.

Claims 1-5, 20, 21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brake (US 6432466) in view of the combination of Jonas (US 4971824) and Arbuckle (Ice Cream, 2nd Edition 1972, page 96). As noted above, in the

final rejection mailed May 5, 2009, to which claim 23 was a newly added claim, a typographical error was made in the heading of the rejection and although claim 23 was clearly addressed in the body of the rejection it was not previous included in the heading.

Brake teaches of a frozen product comprising about 11-69% sweetener (high fructose corn syrup, corn syrup, maltodextrin, sucrose, and FRUITRIM- Column 3 lines 26-36), about 0.2-1.5% stabilizer, about 0-0.12% emulsifier, 0-10% non-fat milk solids, 0-5% milk fat, water, and 20-90% by volume fruit puree including raspberry and strawberry (Abstract, Column 2 line 64 through Column 3 line 17, and Column 4 lines 21-36). Brake teaches that the composition does not include additional emulsifiers by teaching that the composition includes 0% emulsifiers. Regarding the method in which the instantly claimed product is made as recited in claim 1, Brake teaches that the product is produced by method b, comprising homogenizing and pasteurizing a premix containing water, fat, milks solids non fat, and sweetener, cooling the pasteurized mix, and then adding sufficient amounts of fruit puree (Column 4 line 66 through Column 5 line 18).

Brake is silent to the overrun of the aerated product as about 10-250% as recited in claims 1 and 23, to the pH of the product when melted as about 3.5-5.2 as recited in claims 1 and 23, to the specific amount of soluble and non soluble dietary fiber in the product as recited in claims 1, 4, 5, and 23, to the composition as containing no additional stabilizers as recited in claims 1 and 23, to the meltdown initiation time, meltdown resistance and serum leakage properties of the product as recited in claims 1, 21, and 23, and to the product as made by process a, wherein the frozen product is produced by adjusting the pH of the fruit puree to a value above the isoelectric point of any protein to be incorporated in the product, followed by producing a premix comprising fat, non-fat milk solids, sweetener, and about 5-80% of the fruit puree, and then homogenizing and pasteurizing the premix as recited in claim 23.

Jones teaches of a frozen confection comprising fruit puree. Jones teaches that pH must be adjusted within the appropriate range. Jones teaches that a pH which is too high results in an unset food which remains liquid after processing; and pH which is too

high results in a product which can separate. Jones teaches that the pH is less than about 4.5. Refer specifically to Column 2 lines 47-68. Jones teaches the confection has an overrun 18-100% (Column 2 lines 47-53) and that the overrun is adjusted depending on the desired form and hardness of the final product (Column 3 lines 12-28).

Arbuckle teaches that stabilizers and emulsifiers are generally included in frozen confections, however, many excellent frozen confections are made without additional stabilizers and emulsifiers, such as when milk and milk products, which naturally contain stabilizers and emulsifiers, are included in the confections (page 96).

Regarding the overrun of the aerated product as about 10-250%, it would have been obvious to one of ordinary skill in the art at the time the invention was made to aerate the frozen product as taught by Brake to a specific amount from 18-100% depending on the final form and hardness of the final product as taught by Jones. To adjust the amount of overrun to obtain a known result would be within the ordinary skill and ingenuity of one of ordinary skill in the art at the time the invention was made.

Regarding the pH of the product when melted as about 3.5-5.2, it would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust the pH of the frozen fruit confection of Brake to about 4.5 in order to form a final frozen fruit confection which did not remain liquid or separate after processing as taught by Jones. Again, it is noted that as pH is a compositional property and is not altered by the physical state of the matter, the pH of the composition would be the same at the frozen state as it was in the melted state.

Regarding the product as including 0.05 to about 1.5% soluble dietary fiber and 0.1 to about 5% insoluble dietary fiber, as recited in claim 1 and 23, preferably about 0.1 to about 1.2% soluble dietary fiber and 0.2-2% insoluble dietary fiber as recited in claim 4, most preferably about 0.2-1% soluble dietary fiber and about 0.3-1% insoluble dietary fiber as recited in claim 5, wherein the fibers are derived from one or more fruit or vegetables, preferably purees, as recited in claims 2 and 3, as the instant claims, specifically independent claims 1 and 23, recite that a fruit and/or vegetable puree is added to the product to provide the necessary soluble and insoluble fibers and that the

fruit puree is added from about 5-80%; as appellant states in the specification, page 5 line 30 through page 6 line 15, that the necessary dietary fiber is provided by about 5-80% fruit puree including cherry, raspberry and strawberry purees; and as Brake teaches that the composition contains about 20-90% fruit puree, including raspberry, one of ordinary skill in the art at the time the invention was made would expect that the composition as taught by Brake encompass the instantly claimed amount of fiber, wherein the fiber is derived from fruit puree absent any clear and convincing arguments and/or evidence to the contrary; i.e. Since appellant claims and discloses that the claimed fiber is derived from 5-80% fruit puree, including from raspberry puree, and Brake teaches of adding the same type of fruit puree, including raspberry, within the same compositional range, the fruit puree of Brake would inherently impart substantially the same composition properties, i.e. substantially the same amount of fibers, as the instantly claimed fruit puree, and as no other fiber ingredients are instantly claimed or taught by Brake, the final product of Brake would contain substantially the same amount of fibers as the instantly claimed product absent any clear and convincing arguments and/or evidence to the contrary. Furthermore, as Brake teaches that flavor ingredients, including the fruit purees which contained fiber, are added according to the desired taste, taking into account other ingredients (Column 4 lines 21-36), it would have been obvious to one of ordinary skill in the art to adjust the amount of fruit puree flavoring, and thus the amount of dietary fibers in the final product depending on the desired taste of the final product; for example, one would have been motivated to include a greater amount of strawberry fruit puree, and thus a greater amount of fibers, in order to produce a final product with strong strawberry flavoring, wherein one would have been motivated to include less strawberry fruit puree, and less fibers, in order to produce a final product with subtle strawberry flavorings. To adjust the amount of fruit puree, and thus fiber in the final product, depending on the desired taste of the final product would have been obvious and routine determination to one of ordinary skill in the art as suggested by Brake.

Regarding the composition as containing no additional stabilizers, Brake teaches that the composition contains about 0.2-1.5% stabilizers, 0-10% non fat milk solids, and

0-5% milk fat; and Arbuckle teaches that excellent frozen confections are made without additional stabilizers, such as when milk and milk products, which naturally contain stabilizers, are included in the confections. It would have been obvious to one of ordinary skill in the art at the time the invention was made to not include additional stabilizers in the composition of Brake when other compositional ingredients, such as 10% non-fat milk solids and 5% milk fat which naturally acted as stabilizers, were included in the composition in view of Arbuckle. If other ingredients functioned sufficiently as stabilizers it would have been common sense that one of ordinary skill in the art would have been motivated not to include additional stabilizers so that additional costs from buying ingredients, time from measuring and homogenizing, and space for storage would not be required. To adjust the amount of additional stabilizers depending on the natural ability of other compositional ingredients to function as stabilizers would have been obvious and routine determination to one of ordinary skill in the art at the time the invention was made as taught by Arbuckle.

Regarding the method in which the instantly claimed product is made as recited in claim 23, the claim is directed towards a product recited in a product by process claim and Appellant is reminded that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). In the instant case, since appellant claims (claim 1) and discloses in the specification (page 9 line 14 through page 11 line 5) that the same product can be made by two methods (methods a or b), and Brake teaches of producing a product which is made by method b, wherein a premix comprising water, fat, non fat milk solids and sweetener is homogenized and pasteurized, cooled, and then mixed with a fruit puree, the instantly claimed product made by method a as recited in claim 23 which is made by adjusting the pH of the fruit puree to a value above the isoelectric point of any protein to be incorporated in the product, followed by producing a premix comprising fat, non-fat

milk solids, sweetener, and about 5-80% of the fruit puree, and then homogenizing and pasteurizing the premix would be substantially the same as the product taught by Brake, absent any clear and convincing arguments and/or evidence to the contrary.

Regarding the meltdown initiation time of the product as greater than 120 minutes when measured at 20C and the resistance to meltdown and serum leakage properties of the product as recited in claims 1 and 23 and to the meltdown initiation time as greater than 180 minutes as recited in claim 21, as Brake teaches of a frozen product with substantially the same composition as that as instantly claimed and produced by substantially the same method as instantly claimed, one of ordinary skill in the art at the time the invention was made would expect the frozen product as taught by Brake would have substantially the same properties, including meltdown initiation time, resistance to meltdown, and serum leakage properties, as the instantly claimed invention, absent any clear and convincing arguments and/or evidence to the contrary.

#### **(10) Response to Argument**

Appellant's arguments filed in the appeal brief filed August 27, 2009 been fully considered but they are not persuasive.

Appellant argues that Koss does not teach a frozen aerated product that does not contain a stabilizer as Koss teaches that stabilizer is optional, but is typically in an amount up to 1% in a non-fat product and about 0.1-0.5% in other ice cream mixes, as Koss teaches in the preferred embodiments and examples that the compositions contain stabilizers, and as there are no examples of Koss with a fruit puree in the frozen confection without the use of a stabilizer (Brief pages 9-10 and 13). Appellant's argument is not convincing as Koss states on page 21, lines 1-2, "The frozen dessert may include other optional ingredients typically present in conventional frozen desserts such as stabilizers...", thus teaching that the use of additional stabilizers is not required and encompasses the range of 0%. Regarding the preferred embodiments and examples of Koss as requiring the use of stabilizers, preferred embodiments and

examples are disclosed to show the uses of a reference and do not limit the teachings of the reference itself.

Appellant argues that Koss does not teach a frozen aerated product that specifically contains about 0.05 to about 1.5 soluble dietary fiber and 0.1 to about 0.5% insoluble dietary fiber as recited in claim 1 nor the more narrow ranges of fibers recited in claims 4 and 5, that the fruit puree of Koss is an optional ingredient, and that none of the examples of Koss teach a composition comprising a fruit puree (Brief pages 9-12). Appellant's argument is not convincing as Koss teaches of a product with substantially the same amounts of fiber as instantly claimed. As discussed above, as the instant claims, specifically independent claims 1 and 23, recite that a fruit and/or vegetable puree is added to the product to provide the necessary soluble and insoluble fibers and that the fruit puree is added from about 5-80%; as appellant states in the specification, page 5 line 30 through page 6 line 15, that the necessary dietary fiber is provided by about 5-80% fruit puree including cherry, raspberry and strawberry purees; and as Koss teaches that the composition contains 0.5-20% fruit puree, including raspberry, one of ordinary skill in the art at the time the invention was made would expect that the composition as taught by Koss inherently encompass the instantly claimed amount of fiber, wherein the fiber is derived from fruit puree absent any clear and convincing arguments and/or evidence to the contrary; i.e. Since appellant claims and discloses that the claimed fiber is derived from 5-80% fruit puree, including from raspberry puree, and Koss teaches of adding the same type of fruit puree, including raspberry, within the same compositional range, the fruit puree of Koss would inherently impart substantially the same composition properties, i.e. substantially the same amount of fibers, as the instantly claimed fruit puree, and as no other fiber ingredients are instantly claimed or taught by Koss, the final product of Koss would contain substantially the same amount of fibers as the instantly claimed product absent any clear and convincing arguments and/or evidence to the contrary. At the present, appellant has not provided any such arguments and/or evidence to the contrary. Additionally, appellant's arguments are not convincing as preferred embodiments and examples disclosed by a reference show the uses of a reference and do not limit the teachings of the reference itself.

Appellant argues that Koss does not teach criticality of the instantly claimed fiber ranges, that Koss teaches the amount of fruit puree is dependant upon the desired flavoring and not upon stability as the instantly claimed invention, and that Koss does not disclose the amount of fibers as result effective variables for meltdown resistance and stability (Brief pages 9-12). Appellant's argument is not convincing as Koss teaches of a product with substantially the same amounts of fiber as instantly claimed, as discussed above; furthermore as appellant's claims do not recite that the amount of fruit puree is dependant upon stability or that the amount of fibers as result effective variables for meltdown resistance and stability and although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims; See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993); and as appellant has not shown criticality to the instantly claimed fiber ranges.

Appellant argues that Koss does not teach a frozen aerated product that has a meltdown initiation time of greater than about 120 minutes when measured at 20C, preferably greater than 180 minutes as Koss does not teach substantially the same composition as instantly claimed because Koss teaches the inclusion of a stabilizer and does not teach the instantly claimed amount of fibers and as Koss does not teach the product is produced by substantially the same method as instantly claimed (Brief pages 9, 12 and 13). Appellant's argument is not convincing, as stated above, since Koss teaches of a frozen product with substantially the same composition as that as instantly claimed, including 0% additional stabilizer and the instantly claimed amounts of fiber, and as Koss teaches that the product is produced by substantially the same method as instantly claimed, one of ordinary skill in the art at the time the invention was made would expect the frozen product as taught by Koss would have substantially the same properties, including meltdown initiation time, resistance to meltdown, and serum leakage properties, as the instantly claimed invention, absent any clear and convincing arguments and/or evidence to the contrary. At the present time, appellant has provided no such arguments and/or evidence to the contrary.

Appellant argues that Koss does not teach a frozen aerated product that is made by a process that includes adjusting the pH of a fruit or vegetable puree to a value

above its isoelectric point of any protein to be incorporated in the frozen aerated produce, followed by producing, homogenizing, and pasteurizing a premix containing fat, non-fat milk solids, sweetener, and about 5-80% of said fruit puree (Brief pages 9 and 13). First it is noted that in the process limitations recited in claim 1, the argued method, i.e. method a, is an optional limitation. Furthermore, as discussed above, Appellant is reminded that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself; The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985); and since appellant claims (claim 1) and discloses in the specification (page 9 line 14 through page 11 line 5) that the same product can be made by two methods (methods a or b), and Koss teaches of producing a product which is made by method b, wherein a premix comprising water, fat, non fat milk solids and sweetener is homogenized and pasteurized, cooled, and then mixed with a fruit puree, the instantly claimed product made by method a as recited in claim 23 which is made by adjusting the pH of the fruit puree to a value above the isoelectric point of any protein to be incorporated in the product, followed by producing a premix comprising fat, non-fat milk solids, sweetener, and about 5-80% of the fruit puree, and then homogenizing and pasteurizing the premix would be substantially the same as the product taught by Koss, absent any clear and convincing arguments and/or evidence to the contrary. At the present time, appellant has provided no such arguments and/or evidence.

Appellant notes, brief page 15, that the previous, more broad, 103 rejection over a combination of Koss and Brake was previously withdrawn in an office action mailed January 9, 2008. Appellant’s statement is incorrect. The 103 rejection withdrawn in January 9, 2008 was over a combination of Koss and Blake (US 4244981) and not Koss and Brake (US 6432466).

Appellant argues that the teaching of the prior art must be considered as a whole and that the instant rejections have not considered the references as a whole, that hindsight reasoning has been used, and that a showing of several known elements does not provide obviousness. Appellant supports this argument by arguing that Koss teaches that the fruit puree is an optional ingredient, that Brake teaches a stabilizer must be included in the frozen composition and thus teaches away from the present invention and any composition that contains no additional stabilizers, that Koss teaches stabilizers are included in the exemplary compositions, and that there is no teaching to select an appropriate amount of fruit puree to achieve a meltdown resistance indicative of high stability nor for including non-fat dry milk solids at 4-6.5% (Brief pages 16-17).

Appellant's argument is not convincing as

- The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Furthermore, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971); and
- The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

1. Specifically regarding appellant's argument that Koss teaches that the fruit puree is an optional ingredient and that there is no teaching to select an appropriate amount of fruit puree to achieve a meltdown resistance indicative of high stability, appellants argument is not convincing. As discussed above, Koss, the primary reference, teaches of adding up to 20% fruit puree to the confectionary composition, which encompasses the instantly claimed amount of fruit puree and the instant claims do not recite selecting an appropriate amount of fruit puree to achieve a meltdown resistance indicative of high stability". Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims; See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)
2. Specifically regarding appellant's argument that Brake teaches a stabilizer must be included in the frozen composition and thus teaches away from the present invention and any composition that contains no additional stabilizers and that Koss teaches that a stabilizer is included in the exemplary compositions, appellants argument is not convincing. As stated above, Koss teaches that the composition includes 0% additional stabilizer and exemplary compositions of a reference do not limit and teachings of a reference. Additionally, regarding the teachings of Brake to include a stabilizer in the frozen confection, appellant is reminded that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In the instant case Koss teaches that although a stabilizer is typically included in frozen confections, such as the one taught by Brake, the confection of Koss does not require an additional stabilizer, thus when combining the

teachings of the reference, one of ordinary skill in the art would not expect that a stabilizer was required in the confection. Furthermore, it is noted that the teachings of Brake that are relied upon in the rejection of Koss and Brake are related to showing the well known effects and function of non-fat milk solids in confectionary compositions and not to the use of stabilizers.

3. Specifically regarding appellant's argument that there is no teaching for including non-fat dry milk solids in the composition at 4-6.5%, appellant's argument is not convincing. As stated above, Koss teaches of a frozen confection containing a fruit puree and about 1-2% nonfat milk solids; Brake teaches that milk solids non fat were included in frozen confections with fruit purees from 0-10% in order to provide textural properties (Abstract, Column 3 lines 16-25, and Column 4 lines 21-41); thus, based on the teachings and suggestions of the prior art, it would have been obvious to one of ordinary skill in the art at the time the invention was made to adjust the nonfat milk solids in the fruit puree frozen confection as taught by Koss to 0-10%, which encompasses the range of 4-6.5%, depending on the desired textural properties of the final product as taught by Brake. To adjust the level of a known ingredient within known amounts for its known function would have been obvious and routine determination to one of ordinary skill in the art at the time the invention was made.

Appellant argues that the teaching of the prior art must be considered as a whole and that the instant rejections have not considered the references as a whole, that hindsight reasoning has been used, and that a showing of several known elements does not provide obviousness. Appellant supports this argument by arguing that there is no motivation to leave out the additional stabilizers as taught by Brake, since Brake teaches the stabilizer as an integral part of the invention, that one cannot incorporate into Brake the teachings of Jonas regarding pH and overrun while ignoring the central teaching of Jonas that milk based foods are disadvantageous, that although Arbuckle

teaches many confections are made without additional stabilizers when milks are used, since the teachings of Brake that include milk contain stabilizers there would be no motivation to not include additional stabilizers, and that there is no recognition in the references that the level of fibers and the detailed manufacturing process are result effective variables for meltdown resistance (Brief pages 20-22).

Appellant's argument is not convincing as

- The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Furthermore, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).
- The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).
  1. Specifically regarding appellant's argument that there is no motivation to leave out the additional stabilizers as taught by Brake, since Brake teaches the stabilizer as an integral part of the invention and although Arbuckle teaches many confections are made without additional stabilizers when milks are used, since the teachings of Brake that include milk contain stabilizers there would be no motivation to not include additional

stabilizers, appellant's argument is not convincing. As stated above, Brake teaches that the composition contains about 0.2-1.5% stabilizers, 0-10% non fat milk solids, and 0-5% milk fat; and Arbuckle teaches that excellent frozen confections are made without additional stabilizers, such as when milk and milk products, which naturally contain stabilizers, are included in the confections. Thus, as based on the teachings of the prior art, it would have been obvious to one of ordinary skill in the art at the time the invention was made to not include additional stabilizers in the composition of Brake when other compositional ingredients, such as 10% non-fat milk solids and 5% milk fat which naturally acted as stabilizers, were included in the composition in view of Arbuckle; If other ingredients functioned sufficiently as stabilizers it would have been common sense that one of ordinary skill in the art would have been motivated not to include additional stabilizers so that additional costs from buying ingredients, time from measuring and homogenizing, and space for storage would not be required; and To adjust the amount of additional stabilizers depending on the natural ability of other compositional ingredients to function as stabilizers would have been obvious and routine determination to one of ordinary skill in the art at the time the invention was made as taught by Arbuckle. Additionally regarding appellant's argument that since the teachings of Brake that include milk contain stabilizers there would be no motivation to not include additional stabilizers, it is unclear as to what example appellant is referring to. The only example in the reference, Brake, example 1, Column 5, states that the batch of frozen dessert was made with the ingredients of table 1, which encompasses 0% milk fat and 0% non fat milk solids.

2. Specifically regarding appellant's argument that one cannot incorporate into Brake the teachings of Jonas regarding pH and overrun while ignoring the central teaching of Jonas that milk based foods are disadvantageous, the test for obviousness is not whether the features of a secondary

reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references teach of frozen confectionaries and the knowledge of the prior art, i.e. Jonas, supports modifying the reference of Brake. Specifically, Jonas teaches that in a frozen confectionary product containing fruit puree, a pH of about 4.5 forms a final product which does not remain liquid or separate after processing. Thus, as stated above, one would have been motivated to adjust the pH of the frozen fruit puree composition of Brake to about 4.5 in order to form a final product which did not remain liquid or separate after processing as taught Jones.

3. Specifically regarding appellant's argument that there is no recognition in the references that the level of fibers and the detailed manufacturing process are result effective variables for meltdown resistance, appellant's argument is not convincing as the references of record teach of the instantly claimed amount of fibers and manufacturing process and as the instantly claimed invention does not recite that the level of fibers and the detailed manufacturing process are result effective variables for meltdown resistance. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims; See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993)

Appellants argue that the combination of Brake, Jonas, and Arbuckle does not teach or suggest a composition with the recited levels of fibers as instantly claimed (Brief page 22). Appellant's argument is not convincing. As stated above, as the instant claims, specifically independent claims 1 and 23, recite that a fruit and/or vegetable puree is added to the product to provide the necessary soluble and insoluble fibers and that the fruit puree is added from about 5-80%; as appellant states in the specification, page 5 line 30 through page 6 line 15, that the necessary dietary fiber is provided by about 5-80% fruit puree including cherry, raspberry and strawberry purees; and as Brake teaches that the composition contains about 20-90% fruit puree, including raspberry, one of ordinary skill in the art at the time the invention was made would expect that the composition as taught by Brake encompass the instantly claimed amount of fiber, wherein the fiber is derived from fruit puree absent any clear and convincing arguments and/or evidence to the contrary; i.e. Since appellant claims and discloses that the claimed fiber is derived from 5-80% fruit puree, including from raspberry puree, and Brake teaches of adding the same type of fruit puree, including raspberry, within the same compositional range, the fruit puree of Brake would inherently impart substantially the same composition properties, i.e. substantially the same amount of fibers, as the instantly claimed fruit puree, and as no other fiber ingredients are instantly claimed or taught by Brake, the final product of Brake would contain substantially the same amount of fibers as the instantly claimed product absent any clear and convincing arguments and/or evidence to the contrary. Furthermore, as Brake teaches that flavor ingredients, including the fruit purees which contained fiber, are added according to the desired taste, taking into account other ingredients (Column 4 lines 21-36), it would have been obvious to one of ordinary skill in the art to adjust the amount of fruit puree flavoring, and thus the amount of dietary fibers in the final product depending on the desired taste of the final product; for example, one would have been motivated to include a greater amount of strawberry fruit puree, and thus a greater amount of fibers, in order to produce a final product with strong strawberry flavoring, wherein one would have been motivated to include less strawberry fruit puree, and less

fibers, in order to produce a final product with subtle strawberry flavorings. To adjust the amount of fruit puree, and thus fiber in the final product, depending on the desired taste of the final product would have been obvious and routine determination to one of ordinary skill in the art as suggested by Brake.

Appellants argue that the combination of Brake, Jonas, and Arbuckle does not teach or suggest a composition that does not contain additional stabilizers as instantly claimed (Brief page 22). Appellant's argument is not convincing. As stated above, Brake teaches that the composition contains about 0.2-1.5% stabilizers, 0-10% non fat milk solids, and 0-5% milk fat; and Arbuckle teaches that excellent frozen confections are made without additional stabilizers, such as when milk and milk products, which naturally contain stabilizers, are included in the confections. It would have been obvious to one of ordinary skill in the art at the time the invention was made to not include additional stabilizers in the composition of Brake when other compositional ingredients, such as 10% non-fat milk solids and 5% milk fat which naturally acted as stabilizers, were included in the composition in view of Arbuckle. If other ingredients functioned sufficiently as stabilizers it would have been common sense that one of ordinary skill in the art would have been motivated not to include additional stabilizers so that additional costs from buying ingredients, time from measuring and homogenizing, and space for storage would not be required. To adjust the amount of additional stabilizers depending on the natural ability of other compositional ingredients to function as stabilizers would have been obvious and routine determination to one of ordinary skill in the art at the time the invention was made as taught by Arbuckle.

Appellants argue that the combination of Brake, Jonas, and Arbuckle does not teach or suggest a composition which has a meltdown initiation time as instantly claimed (Brief page 22). Appellant's argument is not convincing. As stated above, as Brake teaches of a frozen product with substantially the same composition as that as instantly claimed and produced by substantially the same method as instantly claimed, one of ordinary skill in the art at the time the invention was made would expect the frozen product as taught by Brake would have substantially the same properties, including meltdown initiation time, resistance to meltdown, and serum leakage

properties, as the instantly claimed invention, absent any clear and convincing arguments and/or evidence to the contrary. At the present time, appellant has provided no such evidence and/or arguments.

Appellants argue that the combination of Brake, Jonas, and Arbuckle does not teach or suggest a composition which is processed as instantly claimed (Brief page 22). Appellant's argument is not convincing. As stated above, regarding the method in which the instantly claimed product is made as recited in claim 1, Brake teaches that the product is produced by method b, comprising homogenizing and pasteurizing a premix containing water, fat, milks solids non fat, and sweetener, cooling the pasteurized mix, and then adding sufficient amounts of fruit puree (Column 4 line 66 through Column 5 line 18) and regarding the method in which the instantly claimed product is made as recited in claim 23, the claim is directed towards a product recited in a product by process claim and Appellant is reminded that "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). In the instant case, since appellant claims (claim 1) and discloses in the specification (page 9 line 14 through page 11 line 5) that the same product can be made by two methods (methods a or b), and Brake teaches of producing a product which is made by method b, wherein a premix comprising water, fat, non fat milk solids and sweetener is homogenized and pasteurized, cooled, and then mixed with a fruit puree, the instantly claimed product made by method a as recited in claim 23 which is made by adjusting the pH of the fruit puree to a value above the isoelectric point of any protein to be incorporated in the product, followed by producing a premix comprising fat, non-fat milk solids, sweetener, and about 5-80% of the fruit puree, and then homogenizing and pasteurizing the premix would be substantially the same as the product taught by Brake, absent any clear and convincing arguments and/or evidence to

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the contrary. At the present time, appellant has provided no such evidence and/or arguments.

Appellant argues that Koss, Brake, and Jonas are non-analogous art by arguing that Koss, Brake, and Jonas deal with very different technical problems than appellants and that Arbuckle is a review monograph on Ice Cream (Brief pages 16 and 23). Appellant's argument is not convincing as it has been held that a prior art reference must either be in the field of appellant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the appellant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the references of record, including Koss, Brake, Jonas, and Arbuckle are in the field of appellant's endeavor, i.e. frozen confections.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Kelly Bekker

/Kelly Bekker/

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Supervisory Patent Examiner, Art Unit 1794

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Supervisory Patent Examiner, Art Unit 1700